Attorney Docket No.: 98.41US-CPA(2870/192) PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lawson, et al.

Serial No.: 09/441,832 Group Art Unit: 1617

Filed: November 17, 1999 Examiner: Wells, Lauren Q.

For: Gel-Type Oil Free Cosmetic

RESPONSE PURSUANT TO 37 CFR 1.111

Remarks

I. The Examiner's §112 Rejections

The Examiner maintains that Claims 1, 4, 5, 7, 8, 15, 16, 20, 21, and 24 are indefinite because term "derivative" is, according to the Examiner, not defined and has not been shown to have a definite art recognized definition, therefore, it is unclear. The Examiner also finds Claims 4, 5, 7, 20 and 24 to be indefinite because of the terms "carbohydrate-based", "sucrose-based" and "glucose-based". The issue is whether one of ordinary skill in the art would find these terms unclear. Applicants find no apparent reason in the art, and find no reason set forth a reason in the present action in support of why or how these terms are not clear to one of ordinary skill in the art.

According to MPEP 2173.02, the definiteness of claim language must be analyzed in light of the content of the particular application, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time of the invention. The description in the specification must clearly allow one of ordinary skill in the art to recognize that Applicants invented what is claimed. . . . Thus, the test for sufficiency is whether the disclosure reasonably conveys to the skilled artisan that Applicants possessed at that time the claimed subject matter. *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 31 USPQ2d 1855, 1857, (CAFC 1994)(citing *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1766, 1774 (Fed. Cir. 1993); see also *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Thus, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope. Applicants have shown that both terms, "derivative" and "based", are known in the art by providing the patent references in the previous response. While Applicants acknowledge that prosecution of each patent may be distinct, Applicants also note that the application of the patent laws and rules must be

equitable. Applicants have demonstrated that the terms "derivative" and "based" are known and understood to one of ordinary skill in the art and no reasons have been offered to indicate otherwise.

Applicants, previously, submitted copies of examples of claims using the term "derivative" and "based" as one of ordinary skill in the art would understand its use. See previously submitted U.S. Patent No. 5,976,516; 5,942,213, 5,616,359. The Examiner questions, in response, "What is carbohydrate-based? Is it a carbohydrate compound? Is it something similar to a carbohydrate? and What chemical compounds or modifications are encompassed by the term 'based'?" However, Applicants respectfully respond that the question to ask is whether one of ordinary skill in the art would ask these questions based on the prior art teachings that Applicants have provided demonstrating that the use of these terms in the art by one of ordinary skill. It is not necessary for a description in a specification to describe that which one of ordinary skill in the art would know and understand. A specification is directed to those skilled in the art and need not teach or point out in detail that which is well-known in the art. *In re Myers*, 161 USPQ 668, 671 (CCPA 1969)(citing *In re Nelson*, 47 CCPA 1031, 280 F.2d 172, 126 USPQ 242 (1960)). Applicants have not found any reasoning in the Office Action as to why it is necessary to teach what a "derivative" is or what the term "based" is to one of ordinary skill in the art as Applicants have demonstrated that the term is known and understood by one of ordinary skill in the art.

As previously mentioned, Applicants submitted examples of U.S. patents with respect to the Examiner's rejection of the term "derivative". One of those examples, U.S. Patent Number 5,616,359, also demonstrates the commonly used term "-based" as well (see reference to "egg-based"). Applicants assert that these references demonstrate that the terms are known and understood to one of ordinary skill in the art. The terms as they are used in the references are similar in content and interpretation to the use of the terms in the present application. Therefore, Applicants' use of the terms in the present claims and specification are not indefinite under 112, second paragraph. As previously set forth, under 112, second paragraph, a term is definite if the disclosure reasonably conveys to the skilled artisan that Applicants possessed at that time the claimed subject matter. As the present use of the terms "derivative" and "based" reasonably conveys to one of ordinary skill in the art the claimed subject matter possessed by Applicants and the subject matter is known and understood by one skilled in the art, there is no basis under provisions of §112 that renders the aforementioned terms unclear. The claims of the present invention fully comply with the requirements of §112, and Applicants request that these rejections be withdrawn.

II. The Examiner's Rejection under 35 U.S.C. §103

A. The '420 Reference

In the present Office Action, Claims 1 to 4, 6 to 11, 14 to 18, 21 to 23, and 25 remain rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,567,420 issued to McEleney et al. ("the '420 reference"). In particular, the Examiner is persuaded by the teaching in the '420 reference of a mousse form of the '420 compositions, that the Examiner notes is a "non-emulsion mousse-textured composition." Further, the Examiner points out that oils are not taught in the '420 reference as a major ingredient, but are taught as additives. Finally, the examples of the '420 compositions, according to the Examiner, contain substantially no oil. Although the '420 reference may not be limited necessarily to its examples and preferred embodiments, it is noteworthy that Table 1 of the '420 reference provides a "TYPICAL LOTION FORMULA." In this formula, Applicants have previously shown that the amount of oil in the emulsion is at a minimum 5.98 percent. The fact that there is almost 6 percent oil, and that the formula is an emulsion has never been addressed by the Examiner. These are blatant differences between the typical lotion formula and the compositions of the present invention that seem to be treated as non-existent. Further, the '420 reference at column 3, lines 33 to 38 teaches that the CI is dispersed in an emulsion and applied to the skin.

The compositions of the present invention are non-emulsions. As described in the present specification, at page 7, the absence of oily substances in the compositions of the present invention make it an ideal product for the greater makeup-wearing population that contends with oily skin. In addition, the large amount of water in the composition creates an added benefit of adding water directly to the skin. Because of the mousse-like consistency, the cool burst of moisture is experienced without feeling drippy. This is not taught or described by the '420 reference. Thus, looking at the '420 reference as a whole one of ordinary skill in the art would not be in possession of a non-emulsion containing substantially no oil like that of the present invention, and therefore, the '420 reference fails to render the present invention obvious.

B. The '049 Reference

The Examiner maintains the rejection of Claims 1, 2, 4, 6 to 11, 14 to 17, 21 to 23, and 25 for being obvious in view of the '049 reference. However, the reasons for this are based on the Office Action of December 19, 2002 wherein Applicants did not find a response to Applicants' arguments for the '049 reference and do not find a response to arguments in the present office action. As previously noted, the '049 reference teaches a treatment for suppressing collagen cross-linking by applying an

aminoethyl compound and includes the form of an aqueous solution as taught at column 7, line 37. However, the non-emulsion compositions of the present invention are not taught or suggested by the '049 reference. The '049 reference merely lists literally hundreds of different components in isolation without any teaching of how they are to be combined let alone how they could be combined to achieve a mousse-like gel of the present invention. In the absence of the claimed invention from the prior art, if there is simply no basis upon which to predicate what seems to be the most unlikely combination in the prior art, obviousness is not found. *In re Schoenewaldt*, 145 USPQ 289, 292 (CCPA 1965) (references including a shot gun disclosure fail to give any indication of either the utility or the properties of the claimed compound except as properties were attributable to them by hindsight). Applicants have not found a response to this argument. Further, it is further asserted herein that the teachings of the '049 reference fails to put the present invention of a non-emulsion composition with a mousse-like consistency in the possession of one of ordinary skill in the art.

C. The '420 Reference or The '049 Reference in Combination With The '680 Reference

The Examiner also previously rejected Claims 4 to 6 and 20 to 22 as being obvious in view of the '420 reference or the '049 reference in combination with U.S. Patent No. 5,002,680 ("the '680 reference") and this rejection is presently maintained. The '680 reference teaches emulsions as described in the abstract and the summary of the invention. Therefore, the '680 reference fails to remedy the defect of either the '420 reference or the '049 reference in each of their failures to teach or suggest a non-emulsion composition with a mousse-like texture like that of the present invention.

D. The '420 Reference or The '049 Reference in Combination With The '499 Reference

The Examiner previously rejected Claims 5, 12, 13, 19, 20 and 24 as being obvious in view of the '420 reference or the '049 reference in combination with U.S. Patent No. 5,741,499 ("the '499 reference") and this rejection is presently maintained. As previously noted, Claims 12, 13, and 19 have been withdrawn. Applicants address their comments on this rejection as it applies to Claims 5, 20, and 24. The Examiner notes that the '420 and the '049 references do not teach isoprene glycol or pigment coated with dimethicone. The '499 reference is cited by the Examiner for making such a teaching of isoprene glycol at column 7, line 2 and of silicone coated pigments at column 8, line 66 to column 9, line 15. Without addressing the teachings of the '499 reference with respect to ispoprene glycol and coated pigments, Applicants do not find that the additional '499 reference pertains to Claim 5 because these elements are not described in Claim 5. With respect to Claims 20 and 24, Applicants believe that the '499 reference fails to remedy the underlying deficiency of the '049 and the '420 references with respect

to a non-emulsion composition with a mousse-like consistency. However, further, Applicants find that the '499 reference does not appear to include the word mousse. Applicants have searched manually and by running a query for the word "mousse" in the specification, the claims, and the abstract in the '499 reference and no patents matched the query for abst/mousse nor spec/mousse nor aclm/mousse and pn/5741499. Therefore, Applicants assert that a topical mousse is not taught by the '499 reference, contrary to the assertion made by the Examiner. Thus, the '499 reference in combination with the other cited references fails to teach or suggest the non-emulsion composition having the mousse-like consistency of the present invention.

As presented above, none of the cited references alone or in combination teaches or suggests the present invention because they fail to teach or suggest a mousse-textured composition containing substantially no oil. Accordingly, Applicants respectfully request that the §103 rejections be withdrawn. In view of the arguments presented above in the present submission, the claims are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Date: August 6, 2003

Dorene M. Price, (Reg. No. 43,018)
Estee Lauder Companies
125 Pinelawn Road
Melville, NY 11747
(631) 531-1194